

## REMARKS

### Status of Claims

The Office Action of January 22, 2008, has been received and considered. Claims 1, 36 and 60 have been amended to recite more clearly that the actuator is operable to retract the cannula. Claims 1 and 36 have been amended to recite that the localization wire includes at least one anchor. Applicants have also amended claims 6, 7, 10 and 49 for formal reasons. Applicants submit that the amendments do not add new material, and support for the amendments can be found in the specification and drawings as originally filed. Applicants have amended claims 1, 6, 7, 10, 36, 49 and 60, without prejudice or disclaimer and reserve the right to pursue the originally filed claim during later prosecution of this application or a subsequently filed application. Reconsideration of the outstanding rejections is respectfully requested based on the following remarks.

### Claims 1-13, 36, 60 and 68-74 are Allowable Over Foerster

The Office has rejected claims 1-13, 36, 60 and 68-74, at paragraphs 2-4 of the Office Action, under 35 U.S.C. §102(b) as being anticipated by U.S. Pub. No. 2001/0034528 ("Foerster"). Applicants respectfully traverse the rejection.

Claim 1 is directed to an apparatus for percutaneously implanting a localization wire within a tissue mass, which includes an actuator in operable communication with a cannula. The actuator is and operable between a charged condition and a discharged condition to effect the relative movement of the cannula and a localization wire to expose the distal end of the localization wire to the tissue mass. In contrast to claim 1, Foerster discloses a deployment actuator connector, comprising a center wire that extends axially through a lumen and that is connected to a marker element at one end and to a pull ring at another end. *See* Foerster, para. [0020], [0041]. Foerster does not disclose an actuator that is in operable communication with a cannula, as recited in claim 1. In addition, Foerster does not disclose that the actuator is operable to retract the cannula, as recited in claim 1.

Claim 36 is directed to an apparatus for percutaneously implanting a localization wire within a tissue mass, which includes an actuator operable between a charged condition and a discharged condition to retract the cannula to expose the localization wire to a surrounding tissue mass. In contrast to claim 36, Foerster discloses a deployment actuator connector (a center wire), that is actuated via a pull ring to pull a marker element against a tube until a proximal portion of the connector is severed from the marker element at a predetermined point of weakness. *See* Foerster, para. [0019], [0048]-[0049]. Hence, Foerster does not disclose an actuator that is operable to retract the cannula, as recited in claim 36.

Claim 60 is directed to a method of percutaneously implanting a localization wire into a tissue mass, where the method includes providing an apparatus comprising a cannula and an actuator connected to the cannula, where the actuator is operable between a charged condition and a discharged condition to effect relative movement of the cannula and the localization wire to expose the distal end of the localizing wire. As explained previously, Foerster discloses a deployment actuator connector, comprising a center wire that extends axially through a lumen and that is connected to a marker element at one end and to a pull ring at another end. *See* Foerster, para. [0020], [0041]. Foerster does not disclose an actuator connected to a cannula, as recited in claim 60. In addition, Foerster does not disclose operating the actuator to retract the cannula, as recited in claim 60.

In view of the foregoing reasons, Applicants respectfully submit that Foerster does not anticipate claims 1, 36 or 60. Hence, claims 1, 36 and 60 are allowable, and Applicants respectfully request that the rejection be withdrawn.

Claims 2-4 and 6-13 depend from claim 1. Claims 68-74 depend from claim 60. Hence, claims 2-4 and 6-13 and 68-74 are allowable at least by virtue of their dependency from claims 1 or 60.

## **Obviousness Rejections**

The Office has rejected the following claims as being unpatentable under 35 U.S.C. §103(a):

- claims 14-17, 37-39 and 61-64, in view of U.S. Patent No. 5,534,007 (“St. Germain”);
- claims 18-19, 40-41 and 65, in view of St. Germain and further in view of U.S. Patent No. 6,716,179 (“Burbank”);
- claims 20-30, 42-55 and 66-67, in view of St. Germain, also in view of Burbank, and further in view of U.S. Patent No. 6,813,520 (“Truckai”); and
- 31-35, 56-59 and 75, at paragraphs 18-21 of the Office Action, under 35 U.S.C. §103(a) as being unpatentable over Foerster, in view of Truckai.

Applicants respectfully traverse the rejections. As explained previously, claims 1, 36 and 60 are allowable over Foerster. Thus, Applicants respectfully submit that claims 14-30, 37-47, 48-59, 61-67 and 75, are allowable at least by virtue of their dependency from claims 1, 36 or 60.

## **CONCLUSION**

Applicant(s) respectfully submit that the present application is now in condition for allowance. Accordingly, the Examiner is requested to issue a Notice of Allowance for all pending claims.

Should the Examiner deem that any further action by the Applicants would be desirable for placing this application in even better condition for issue, the Examiner is requested to telephone Applicants’ undersigned representative at the number listed below.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-3797.

Respectfully submitted,

04-14-2008  
Date

Chad M. Herring  
Chad M. Herring, Reg. No. 41,067  
Attorney for Applicant(s)  
LARSON NEWMAN ABEL  
POLANSKY & WHITE, LLP  
5914 West Courtyard Drive, Suite 200  
Austin, TX 78730  
(512) 439-7100 (phone)  
(512) 439-7199 (fax)